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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,746	05/19/2004	Ronald R. Snyder SR.	27383 USA	8578
23307	7590	06/02/2005	EXAMINER	
SYNNESTVEDT & LECHNER, LLP			FULTON, CHRISTOPHER W	
2600 ARAMARK TOWER			ART UNIT	
1101 MARKET STREET			PAPER NUMBER	
PHILADELPHIA, PA 191072950			2859	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/849,746

Applicant(s)

SNYDER ET AL.

Examiner

Christopher W. Fulton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12-20, 22 and 29-33 is/are rejected.
- 7) ☒ Claim(s) 7-11, 21 and 23-28 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/19/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 13-20, 29, 30, 32, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Cushenbery et al.

The device as claimed is disclosed by Cushenbery et al with a body 18 having a receptacle therein sized to receive the end of a pipe 12, a first marking tool 28 (scoring tool) mounted on and protruding into the receptacle of the body with a contact surface to create a mark on the pipe upon rotation of the pipe, an elongated polygonal shaped shaft 56 oriented substantially coaxially with the receptacle and extending outwardly from the receptacle with the body being rotatable upon rotation of the shaft, and the pipe having a pair of circumferential grooves (86,88).

3. Claims 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee.

The device as claimed is disclosed by Lee with a body 32 having a receptacle therein sized to receive the end of a pipe and a first marking tool 12 (writing implement) mounted on and protruding into the receptacle of the body with a contact surface to create a mark on the pipe upon rotation of the pipe.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cushenbery et al in view of applicants admitted prior art.

The device as claimed is disclosed by Cushenbery et al as stated in the rejection recited above for claims 1-3, 13-20, 29, 30, 23, and 33, but lacks a second marking tool to mark a second witness mark. Applicant has admitted at page 3 lines 5-19 of the specification that a plurality of spaced witness marks are known to be used on pipes as indicators. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a second marking tool spaced from the first marking tool in Cushenbery et al as taught by applicants admitted prior art to place a plurality of spaced marks on a pipe.

7. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cushenbery et al in view of Jiles.

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The device as claimed is disclosed by Cushenbery et al as stated in the rejection recited above for claims 1-3, 13-20, 29, 30, 23, and 33, but lacks the body also having a cutting blade to chamfer the end of the pipe. Jiles teaches using a cutting blade extending into a receptacle to chamfer the end of a pipe. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a cutting blade to the body of Cushenbery et al as taught by Jiles to simultaneously chamfer the end of the pipe.

Allowable Subject Matter

8. Claims 7-11, 21, and 23-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

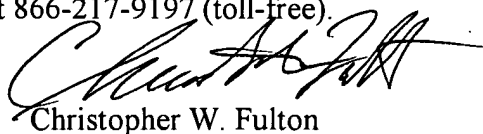
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Oswald and Behnke both show marking grooves on pipes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher W. Fulton whose telephone number is (571) 272-2242. The examiner can normally be reached on M-Th 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher W. Fulton
Primary Examiner
Art Unit 2859

CWF